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Mark Bresnan

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EXAMINER

WU, RUTAO

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/736,998	<b>Applicant(s)</b> BRESNAN ET AL.	
	<b>Examiner</b> ROB WU	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-25,27-32,35-53 and 55-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-25,27-32,35-53 and 55-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

1. In response filed October 17 2008, the applicant amended claims 1, 13, 14, 24, 27, 30, 41, 42, 52 and 55. Claims 4, 5, 26, 33, 34 and 54 have been cancelled. Claims 1-3, 6-25, 27-32, 35-53, 55-57 are pending in the current application.

### ***Response to Arguments***

2. Applicant's arguments, see page 13, filed October 17 2008, with respect to claims 5, 13, 14, 34, 41 and 42 have been fully considered and are persuasive. The 35. U.S.C. § 112 rejection of claims 5, 13, 14, 34, 41 and 42 has been withdrawn.
3. Applicant's arguments, see page 13, filed October 17 2008, with respect to claims 24, 25, 27-29 have been fully considered and are persuasive. The 35. U.S.C. § 101 rejection of claims 24, 25, 27-29 has been withdrawn.
4. Applicant's arguments regarding the 35. U.S.C. § 101 rejection of claims 52, 53 and 55-57 have been fully considered but they are not persuasive.

Claim 52 is directed to a method for processing and preparing a plurality of messages which recite purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, claims 52, 53 and 55-57 are non-statutory since they may be performed within the human mind.

5. Applicant's arguments regarding claims 1-3, 6-25, 27-32, 35-53, 55-57 have been fully considered but they are not persuasive.

With regards to claim 1, the claim now recites the additional language of "wherein the first criteria include marketing business rules determined by the customer relationship management system; and wherein the marketing rules include a rule whether messages that include particular marketing content may be consolidated." The applicant asserts that Savage et al does not teach or disclose rules for whether particular marketing content may be consolidated. The Examiner respectfully disagrees. Savage et al disclose that consolidating marketing contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Because it is well known business rule that a business will want to lower its cost and therefore generate more revenue, therefore, it would have been obvious at the time of the invention that Schumacher would have the motivation to allow the senders to choose whether to consolidate contents to thereby reduce cost as disclosed by Savage et al.

With regards to claim 6-8, and 35-37, the applicant asserts that Johnson does not teach using customer preferences to determine whether consolidation or householding is desired in the first place. The Examiner respectfully disagrees.

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Johnson discloses that the recipient can opt for paper delivery of the consolidated bills, and allowing the post office to determine the best routing method accordingly. [0029] Therefore, the recipient by opting for paper delivery of the consolidated bills is in fact asserting their preference.

With regards to claim 52, the claim now recites the additional language of "wherein the step of consolidating includes determining whether a customer preference authorizes consolidating for a particular message, and whereby consolidating is disallowed if there is no authorization." The applicant asserts that neither Schumacher or Stepno disclose or suggest "the step of consolidating includes determining whether a customer preference authorizes consolidation for a particular message." The Examiner respectfully disagrees. It would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of consolidation and not perform consolidation unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing consolidation so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 52, 53, 55-57 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In *re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, claims 52, 53, 55-57 are non-statutory since they may be performed within the human mind.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 30 includes limitation that recites "including a step of preventing messages from being consolidated based on the marketing rules that include a rule whether messages that include particular marketing content may be consolidated." If messages are prevented from being consolidated even when there is a marketing rule that states that the particular marketing content may be consolidated, then it is ambiguous as to the patentable weight of the marketing rules determining step as well as the marketing rules themselves as claimed in the application if the marketing rules are being ignored.

10. For the purpose of expediting the prosecution the Examiner assumes the limitation to be "including a step of preventing messages from being consolidated based on the marketing rules that include a rule whether messages that include particular marketing content may not be consolidated."

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 1-3, 9-17, 30-32, 38-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat No. 5,058,030 to Schumacher in view of U.S. Pat No. 7,236,950 to Savage et al.

**Referring to claim 1:**

Schumacher discloses

A message processing system for preparing a plurality of messages to be distributed to recipients, the system comprising:

A consolidator module receiving data corresponding to the plurality of messages, the consolidator module programmed to consolidate multiple of the plurality of messages into a single message package, the consolidator module consolidation the message based on first criteria; (col 4: lines 36-40; col 10: lines 38-40)

A customer relationship management system coupled to the consolidator module, the customer relationship management system determining at least some of the first criteria (col 10: lines 20-27)

wherein the first criteria include marketing business rules determined by the customer relationship management system. (col 4: lines 15-21)

Schumacher does not expressly disclose wherein the marketing rules include a rule that message that include particular marketing content may, or may not, be consolidated.

Savage et al disclose that consolidating marketing contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)



Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain marketing contents to be consolidated or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by consolidating contents.

**Referring to claim 2:**

Schumacher discloses

The message processing system of claim 1 wherein the customer relationship management system determines a template for message packages and the template is transmitted to the consolidator module for forming the message packages. (col 10: lines 31-40)

**Referring to claim 3:**

Schumacher discloses

The message processing system of claim 2 wherein the template includes marketing content developed by marketing tools in the customer relationship management system. (col 10: lines 31-40)

**Referring to claim 9:**

Schumacher discloses

The message processing system of claim 1 wherein the consolidator module is coupled to a statement applications processing module, the statement applications processing module determining at least some of the first criteria. (col 11: lines 8-11)

**Referring to claim 10:**

Schumacher discloses

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The message processing system of claim 9 wherein the statement applications processing module provides message business data to the consolidator module for forming the message packages. (col 11: lines 8-11)

**Referring to claim 11:**

Schumacher discloses

The message processing system of claim 9 wherein the statement applications processing module receives data from an automated data factory having a plurality of mail production sites. (col 11: lines 5-11)

**Referring to claim 12:**

Schumacher discloses

The message processing system of claim 9 wherein the first criteria include sender rules received from the statement applications processing module. (col 11: lines 7-11)

**Referring to claim 13:**

Schumacher does not expressly disclose that the message processing system of claim 12 wherein the first criteria include a rule that whether message that include particular business content may be consolidated.

Savage et al disclose that consolidating business contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business contents to be consolidated or

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not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by consolidating contents.

**Referring to claim 14:**

Schumacher does not expressly disclose that the message processing system of claim 12 wherein the first criteria include a rule that whether message that include particular business content may be householded.

Savage et al disclose that householding business contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business contents to be householded or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by consolidating contents.

**Referring to claim 15:**

Schumacher discloses

The message processing system of claim 12 wherein the sender rules include a requirement to maximize throughput of message packages, and whereby the consolidator module forms in order to maximize throughput. (col 4: lines 22-39)

**Referring to claim 16:**

Schumacher discloses

The message processing system of claim 12 wherein the sender rules include a requirement to minimize mail production costs, and whereby the consolidator module

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form and route message packages in order to minimize mail production costs. (col 4: lines 15-21)

**Referring to claim 17:**

Schumacher discloses

The message processing system of claim 1 wherein the consolidator selects messages for consolidation from the plurality of messages based on the messages including a same delivery address. (col 10: lines 31-40)

**Referring to claim 30:**

A method for processing and preparing a plurality of messages to be distributed to recipients, the method comprising:

Schumacher discloses

Receiving data corresponding to the plurality of messages; (col 4: lines 36-40; col 10: lines 38-40)

Consolidating multiple of the plurality of messages into single message packages, said consolidating of the messages into consolidated message packages based on first criteria; (col 4: lines 36-40; col 10: lines 38-40)

determining at least some of the first criteria through a customer relationship management system wherein the step of determining the first criteria include marketing business rules determined by the customer relationship management system. (col 4: lines 9-21)

Schumacher does not expressly disclose of preventing messages from being consolidated based on the marketing rules that include a rule that message that include particular marketing content may not be consolidated.

Savage et al disclose that consolidating marketing contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain marketing contents to be consolidated or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by consolidating contents.

**Referring to claim 31:**

Schumacher does not expressly disclose the method of claim 30 further comprising the step of determining a template for message packages with the customer relationship management system.

However, it would have been obvious at the time of the invention that a template for message packages is determined with the customer relationship management system. The template is determined such that the customer will receive consolidated mailing that is addressed to the customer.

**Referring to claim 32:**

Schumacher discloses the method of claim 31 wherein the step of determining the template comprises including marketing content developed by marketing tools in the customer relationship management system. (col 4: lines 36-40)

**Referring to claim 38:**

Schumacher discloses the method of claim 30 further including the step of determining at least some of the first criteria with a statement applications processing module. (col 11: lines 8-11)

**Referring to claim 39:**

Schumacher discloses the method of claim 38 further including the step of providing message business data from the statement applications processing module for forming the message packages. (col 11: lines 8-11)

**Referring to claim 40:**

Schumacher discloses the method of claim 38 wherein the step of determining at least some of the first includes incorporating sender rules received from the statement applications processing module. (col 10: lines 20-26)

**Referring to claim 41:**

Schumacher does not expressly disclose the method of claim 40 wherein the step of consolidating is controlled by the first criteria which includes a sender rule that messages that include particular business content may, or may not, be consolidated.

Savage et al disclose that consolidating business contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business contents to be consolidated or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by consolidating contents.

**Referring to claim 42:**

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Schumacher does not expressly disclose the method of claim 40 wherein the step of consolidating is controlled by the first criteria which includes a sender rule that messages that include particular business content may, or may not, be householded.

Savage et al disclose that householding business contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business contents to be householded or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by householding contents.

**Referring to claim 43:**

Schumacher discloses the method of claim 40 wherein the sender rules include a requirement to maximize throughput of message packages, and the steps of consolidating is controlled to form message packages in order to maximize throughput. (col 4: lines 22-39)

**Referring to claim 44:**

Schumacher discloses the method of claim 40 wherein the sender rules include a requirement to minimize mail production costs, and the wherein the steps of consolidating is controlled to form message packages in order to minimize mail production costs. (col 4: lines 15-21)

**Referring to claim 45:**

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Schumacher discloses the method of claim 30 wherein the step of consolidating includes selecting messages for consolidation from the plurality of messages based on the messages having a same delivery address. (col 4: lines 35-40)

13. Claims 6-8, 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher in view of Savage et al in further view of U.S. Pub No. 2004/0230523 to Johnson.

**Referring to claim 6:**

Schumacher disclose consolidating mailing inserts based on plurality of factors. Schumacher does not expressly disclose that the message processing system of claim 1 wherein the first criteria include customer preferences.

Johnson disclose that the recipient can opt for paper delivery of the consolidated bills, and allowing the post office to determine the best routing method accordingly.

[0029]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to process the messages based on customer preference. Schumacher would be motivated to perform such modification to provide convenience to the customers.

**Referring to claim 7:**



Schumacher does not expressly disclose the message processing system of claim 6 wherein the first criteria includes a customer preference on whether or not consolidation is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether consolidation is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

**Referring to claim 8:**

Schumacher does not expressly disclose the message processing system of claim 6 wherein the first criteria includes a customer preference on whether or not householding is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether householding is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not sending information about multiple customers to one place.

**Referring to claim 35:**

Schumacher disclose consolidating mailing inserts based on plurality of factors. Schumacher does not expressly disclose gathering customer preference data and including it in the first criteria.

Johnson disclose that the recipient can opt for paper delivery of the consolidated bills, and allowing the post office to determine the best routing method accordingly.

[0029]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to process the messages based on customer preference. Schumacher would be motivated to perform such modification to provide convenience to the customers.

**Referring to claim 36:**

Schumacher does not expressly disclose the method of claim 35 wherein the step of consolidating is controlled based on the first criteria which includes a customer preference on whether or not consolidation is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether consolidation is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

**Referring to claim 37:**

Schumacher does not expressly disclose the method of claim 35 wherein the step of consolidating is controlled based on the first criteria which include a customer preference on whether or not householding is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether householding is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not sending information about multiple customers to one place.

14. Claims 18-20, 22, 24, 25, 28, 46-48, 50, 52-53, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher in view of Savage et al in further view of U.S. Pub No. 2002/0133472 to Stepno.

**Referring to claim 18:**

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose that the message processing system of claim 17 wherein the consolidator selects messages for consolidation based on messages having due dates proximal in time.

Stepno discloses consolidating messages based on messages having due dates proximal in time. [0015], [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also consolidate the message

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based on due dates proximal in time. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 19:**

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose the message processing system of claim 18 wherein due dates of messages selected for consolidation are adjusted by the consolidator module to match.

Stepno discloses due dates on the message are adjusted by the consolidator.

[0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to adjust the due date of the messages in order to consolidate them. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 20:**

Schumacher does not expressly disclose the message processing system of claim 18 wherein the consolidator module determines whether a customer preference authorizes consolidation for a particular message, and whereby consolidation is disallowed by the consolidator module is there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of consolidation and not perform consolidation unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher

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would be motivated to do seek authorization before performing consolidation so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

**Referring to claim 22:**

Schumacher does not expressly disclose that the message processing system of claim 18 wherein the consolidator module determines whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of householding and not perform householding unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing householding so to provide convenience and protect the privacy and personal information of the recipient by not sending person information of plurality of recipient to the same address.

**Referring to claim 24:**

Schumacher discloses a message processing system for preparing a plurality of messages to be distributed to customers, the system comprising:

A consolidator module receiving data corresponding to the plurality of messages, the consolidator module programmed to consolidate multiple of the plurality of messages into a single message package, the consolidator module consolidation the message based on first criteria, (col 4: lines 36-40; col 10: lines 38-40)

Schumacher does not expressly disclose the consolidator selects messages for consolidation based on messages having due dates proximal in time.

Stepno discloses consolidating messages based on messages having due dates proximal in time. [0015], [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also consolidate the message based on due dates proximal in time. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

Schumacher combined with Savage et al and Stepno does not expressly disclose wherein the consolidator module determines whether a customer preference authorizes consolidation for a particular message, and whereby consolidation is disallowed by the consolidator module is there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of consolidation and not perform consolidation unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing consolidation so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

**Referring to claim 25:**

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose the message processing system

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of claim 24 wherein due dates of messages selected for consolidation are adjusted by the consolidator module to match.

Stepno discloses due dates on the message are adjusted by the consolidator.

[0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to adjust the due date of the messages in order to consolidate them. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 28:**

Schumacher does not expressly disclose that the message processing system of claim 24 wherein the consolidator module determines whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of householding and not perform householding unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing householding so to provide convenience and protect the privacy and personal information of the recipient by not sending person information of plurality of recipient to the same address.

**Referring to claim 46:**

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose selecting messages for consolidation based on messages having due dates proximal in time.

Stepno discloses consolidating messages based on messages having due dates proximal in time. [0015], [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also consolidate the message based on due dates proximal in time. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 47:**

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose wherein the step of consolidating includes adjusting the due dates of messages selected for consolidation so that consolidated messages have the same due dates.

Stepno discloses due dates on the message are adjusted by the consolidator. [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to adjust the due date of the messages in order to consolidate them. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 48:**



Schumacher does not expressly disclose determining whether a customer preference authorizes consolidation for a particular message, and whereby consolidation is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of consolidation and not perform consolidation unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing consolidation so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

**Referring to claim 50:**

Schumacher does not expressly disclose determining whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of householding and not perform householding unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing householding so to provide convenience and protect the privacy and personal information of the recipient by not sending person information of plurality of recipient to the same address.

**Referring to claim 52:**

Schumacher discloses a method for processing and preparing a plurality of messages to be distributed to recipients, the method comprising:

receiving data corresponding to the plurality of messages; (col 4: lines 36-40; col 10: lines 38-40)

consolidating multiple of the plurality of messages into a single message package, said consolidating of the messages into consolidated message packages based on first criteria, (col 4: lines 36-40; col 10: lines 38-40)

Schumacher does not expressly disclose the consolidator selects messages for consolidation based on messages having due dates proximal in time.

Stepno discloses consolidating messages based on messages having due dates proximal in time. [0015], [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also consolidate the message based on due dates proximal in time. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

Schumacher combined with Savage et al and Stepno does not expressly disclose wherein the step of consolidating includes determining whether a customer preference authorizes consolidation for a particular message, and whereby consolidation is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of consolidation and not perform consolidation unless an authorization is found. As it is well known in the art

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that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing consolidation so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

**Referring to claim 53:**

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose wherein the step of consolidating includes adjusting the due dates of messages selected for consolidation so that consolidated messages have the same due dates.

Stepno discloses due dates on the message are adjusted by the consolidator.

[0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to adjust the due date of the messages in order to consolidate them. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

**Referring to claim 56:**

Schumacher does not expressly disclose determining whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of householding and not perform householding unless an authorization is found. As it is well known in the art

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that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing householding so to provide convenience and protect the privacy and personal information of the recipient by not sending person information of plurality of recipient to the same address.

15. Claims 21, 23, 27, 29, 49, 51, 55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher in view of Savage et al in view of Stepno in further view of Johnson.

**Referring to claims 21, 23, 27, 29, 49, 51, 55 and 57:**

Schumacher combined with Stepno disclose sending advertisements with the message to the recipient. (Schumacher col 4: lines 36-40) Schumacher combined with Stepno does not expressly disclose if the customer preference does not authorize consolidation or householding, the consolidator generates content to be included in the message that describes benefits of consolidation or householding.

Johnson disclose that sellers often offer discounts for quick payment. [0006] Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher combined with Stepno to send an advertisement describing the advantages of message consolidation to the recipient, such as discounts offered.

***Conclusion***

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16. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROB WU whose telephone number is (571)272-3136.

The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. W./  
Examiner, Art Unit 3628

/John W Hayes/  
Supervisory Patent Examiner, Art Unit 3628